

**REMARKS/ARGUMENTS**

Upon entry of the above amendment, claims 13-29, and 32-34 will not have been amended but are being resubmitted for reconsideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for an indication of the allowability of claims 30, 31, 35 and 36.

Turning to the merits of the action, the Examiner has rejected claims 13-15 and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of RFC 2305 (RFC2305\_ "A Simple Mode of Facsimile Using Internet MAIL" March 1998). The Examiner also has rejected claims 16-19, 23-27, and 32 under 35 U.S.C § 103 (a) as being unpatentable over TOYODA et al. (U.S. Patent Number 5,812,278) in view of PRAITIS et al. (U.S. Patent No. 6,594,697) and MORI (U.S. Patent No. 6,417,930). The Examiner further has rejected claims 28-29 and 33-34 under 35 U.S.C § 103 (a) as being unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of PRAITIS et al. (U.S. Patent No. 6,594,697), MORI (U.S. Patent No. 6,417,930), and IWAZAKI (U.S. Patent No. 6,687,742).

As noted above, claims 13-29, and 32-34 remain pending for consideration. Applicant notes that claims 30-31 and 35-36 are allowable. Applicant respectfully traverses the above rejections of pending claims 13-29 and 32-34, and will discuss the

rejections with respect to the pending claims in the present application as will be set forth hereinbelow.

Applicant's claims 13-15 relate to an image communication apparatus which has a transmitter configured to transmit an e-mail with data attached, via a computer network and has a receiver configured to receive an e-mail with data attached, via the computer network. The image communication apparatus comprises a controller configured to convert the attached data into image data. The controller judges whether or not the received e-mail is an error mail, based on whether or not a header of the received e-mail includes a predetermined character string. The predetermined character string is related to a sender of the error mail. The error mail is related to the e-mail transmitted by the image communication apparatus. Claims 20-22 recite related methods.

Applicant's claims 16-19 relates to an image communication apparatus which transmits and receives an e-mail. The e-mail includes a header and a body which has a message. The message includes an image data part. The image communication apparatus has a transmitter configured to transmit an e-mail with data attached, via a computer network and has a receiver configured to receive an e-mail with data attached, via the computer network. The image communication apparatus also has a controller configured to convert the attached data to image data. The controller further searches for a predetermined image data fixed code in the image data part of the body of the e-mail when the received e-mail is a multi-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is

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detected. The error mail is related to an e-mail transmitted by the image communication apparatus. Claims 23-26 recite related methods.

Applicant's claims 27-29 relate to an image communication apparatus connected to a server and configured to receive an e-mail. The e-mail includes a header and a body which has a message. The message includes an image data part. The image communication apparatus has a transmitter configured to transmit an e-mail with data attached, via the server and has a receiver configured to receive an e-mail to which data is attached, via the server. The image communication apparatus has a converter configured to convert the attached data into image data. The image communication apparatus also has a memory configured to store a predetermined image data fixed code. Further, the image communication apparatus has a controller which searches for a predetermined header fixed message in the header of the received e-mail, searches for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not found in the header of the received e-mail, and judges that the received e-mail is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory. The error mail is related to an e-mail transmitted by the image communication apparatus. Claims 32-34 recite related methods.

Regarding the rejection of claims 13-15 and 20-22 under 35 U.S.C. § 103(a), the Examiner asserts that the recited features of the controller are disclosed ("substantially as claimed") in TOYODA et al. However, the cited portions of TOYODA et al. merely disclose judging whether or not an error occurs in a transmission of print data to the

facsimile (col. 6, lines 38-46) and recognizing identification information of a transmitter and a receiver's electronic mail address which are written in the received facsimile data (col. 6, lines 57-61). TOYODA et al. also discloses that when a receiver's e-mail is received as error information for a transmitter's e-mail, the receiver's e-mail is changed to receiver's facsimile data and the receiver's facsimile data is transmitted to the transmitter specified by the identification information of the transmitter (col. 7, lines 52-63).

However, TOYODA et al. does not disclose judging whether received e-mail is error mail, based on the contents of a header, as recited. Additionally, TOYODA et al. does not disclose a header of a received e-mail which includes a predetermined character string, the predetermined character string being related to a sender of the error mail, as recited.

In this regard, the Examiner asserts in the outstanding Official Action mailed on December 1, 2005 that "TOYODA et al. taught to judge whether or not the received e-mail is an error mail, the error mail being related to an e-mail transmitted by the image receiving apparatus based on a header of the received e-mail (col. 6, lines 38-46, lines 57-61 and col. 7, lines 52-63)". Applicant notes that col. 6, lines 38-46 relates to Fig. 20 and corresponds to col. 19, lines 51-67, and col. 20, lines 1-52. Similarly, col. 6, lines 57-61 and col. 7, lines 52-63 relate to Fig. 32 and corresponds to col. 28, lines 20-59.

Regarding Fig. 20, col. 19, lines 51-67, and col. 20, lines 1-52 which relate to col. 6, lines 38-36, TOYODA et al. therein discusses a facsimile type electronic mail apparatus which functions as a relay apparatus. In particular, a personal computer

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transmits print data to a facsimile type electronic mail apparatus that transmits the print data to a facsimile designated by the facsimile number. The facsimile type electronic mail apparatus determines whether an error occurs in the facsimile transmission. When the error occurs in the facsimile transmission, the facsimile type electronic mail apparatus extracts the electronic mail address from the print data and informs an error information receiving apparatus designated by the electronic mail address of the occurrence of the error in the facsimile transmission.

However, these cited portions of TOYODA et al. do not teach an image communication apparatus which judges whether or not the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image communication apparatus, based on whether or not a header of the received e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail. Rather, the cited portions merely teach how the system responds when an error occurs in the facsimile transmission (col. 20, lines 37-39 and step S188 of Fig. 20). In other words, the cited portions do not relate to judging whether or not a received e-mail is error mail at all, but relate to what happens when such a facsimile transmission error occurs. Thus, TOYODA et al. does not teach an image communication apparatus which judges whether or not the received e-mail is an error mail, based on whether or not a header of the received e-mail includes a predetermined character string.

Regarding Fig. 32 and col. 28, lines 20-59 which relate to col. 6, lines 57-61 and col. 7, lines 52-63, TOYODA et al. teaches that a receiver's electronic mail address and an informing electronic mail address, partitioned by a symbol #, are written in a sub-

address of the facsimile data in advance. The informing electronic mail address indicates the first personal computer 64. When the facsimile apparatus 71 receives the facsimile data from the facsimile apparatus 62, the facsimile apparatus 71 recognizes the receiver's electronic mail address and the informing electronic mail address written in the facsimile data. The facsimile apparatus 71 converts the facsimile data into a transmitter's electronic mail, registers the informing mail address of the transmitter as a transmitter's electronic mail address in a header of the transmitter's electronic mail, and transmits the transmitter's electronic mail to the second personal computer. A receiver's electronic mail indicating error information is directly transmitted from the second personal computer 64 to the first personal computer without passing the facsimile apparatus 71.

However, these cited portions also do not teach an image communication apparatus which judges whether or not the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image communication apparatus, based on whether or not a header of the received e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail. Rather, the cited portions merely teach that a receiver's electronic mail address and an informing electronic mail address partitioned by a symbol # are written in a sub-address of the facsimile data (col. 28, lines 28-31). The facsimile apparatus 71 receives the facsimile data (col. 28, lines 37-38), but does not receive an e-mail. Thus, the facsimile apparatus 71 cannot judge whether or not the received e-mail is an error mail based on the receiver's electronic mail address and the informing electronic mail address written in a sub-address of the facsimile data. Further, the facsimile

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apparatus 71 registers the informing mail address of the transmitter as a transmitter's electronic mail address in a header of the transmitter's electronic mail (col. 28, lines 43-46). However, the facsimile apparatus 71 does not judge whether or not the received e-mail is an error mail based on the informing mail address of the transmitter registered in a header of the transmitter's electronic mail, since the informing mail address of the transmitter is merely used for transmitting a receiver's electronic mail indicating error information to the first personal computer (col. 28, lines 50-54). Fig. 32 does not show any decisions for judging or determining whether or not the received e-mail is an error mail.

As discussed above, TOYODA et al. does not contain any disclosures regarding an image communication apparatus which judges whether or not the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image communication apparatus, based on whether or not a header of the received e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail.

Thus, the pending claims are clearly distinguished over TOYODA et al.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 13-15 and 20-22 are not disclosed or even suggested in TOYODA et al. cited by the Examiner.

Furthermore, in setting forth the rejection, the Examiner asserts that "TOYODA provided a motivation to modify the image apparatus with the predetermined character string being related to a sender of the error mail (col. 6, lines 57-61, col. 7, lines 52-63)". However, as discussed above, the cited portions merely teach that the print data

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includes the facsimile number and the electronic mail address (col. 20, lines 24-25 and lines 41-42), and that the facsimile type electronic mail apparatus determines whether or not an error occurs in the facsimile transmission (col. 20, lines 37-39 and step S188 of Fig.20). The cited portions also merely teach that a receiver's electronic mail address and an informing electronic mail address are written in a sub-address of the facsimile data (col. 28, lines 28-31). Thus, contrary to the Examiner's assertions, Applicant submits that TOYODA et al. does not provide any motivation to modify the image communication apparatus with the predetermined character string being related to a sender of the error mail.

Should the Examiner persist in asserting that any portion of TOYODA et al., discloses the above-noted features, he is respectfully requested to provide a citation thereto, rather than to the above-discussed portions which clearly do not disclose the recited features. In other words, the Examiner is respectfully requested to indicate where in TOYODA et al. the precise recited features are disclosed.

In setting forth the rejection, the Examiner relies on RFC 2305 to supply the shortcoming of TOYODA et al. However, RFC 2305 merely provides a general explanation for a simple mode of facsimile transmission using Internet mail. Particularly, sections 2.2.1 refers to a general explanation of Headers, and sections 5.1, 5.2.1, and 5.2.2 refer to avoiding unsolicited e-mails by verifying the identity of the sender, such as by encryption-based authentication. However, RFC 2305 does not disclose how to judge whether or not the received e-mail is an error mail, since RFC 2305 relates to a general explanation for a simple mode of facsimile transmission using



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Internet mail. Thus, RFC 2305 does not disclose the features of the present invention that are missing from TOYODA et al.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 13-15 and 20-22 are not disclosed in RFC 2305 cited by the Examiner. Thus, pending claims 13-15 and 20-22 are submitted to be patentable over the Examiner's proposed combination, since neither TOYODA et al. nor RFC 2305 discloses the combination of features recited in Applicant's claims. Specially, TOYODA et al. does not provide any suggestions for modifying the image apparatus by the utilization of a predetermined character string that is related to a sender of the error mail, as recited in at least claim 13.

Regarding the rejection of claims 16-19, 23-27, and 32 under 35 U.S.C. § 103 (a), as explained above, TOYODA et al. does not disclose the controller of claim 16 that is configured to search for a predetermined image data fixed code and to judge received e-mail as error mail when the predetermined fixed data fixed code is detected. Nor does TOYODA et al. disclose the searching and judging of claim 23.

Further, the Examiner has admitted, in the outstanding Official Action mailed on December 1, 2005, that TOYODA et al. does not disclose a controller which searches for a predetermined image data fixed code in the image data part of the body of the e-mail when the received e-mail is a multi-part structure, and to judge that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected.

Thus, TOYADA et al. does not contain any disclosure regarding a controller which searches for a predetermined image data fixed code in the image data part of the

e-mail when the received e-mail is a multi-part structure. TOYADA et al. also does not contain any disclosure regarding a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected. Should the Examiner persist in asserting that any portion of TOYODA et al. discloses the above-noted feature, he is respectfully requested to provide a cite thereto, rather than to the above-discussed portions which do not disclose the recited features. In other words, the Examiner is respectfully requested to indicate where in TOYODA et al. the precise recited features are disclosed.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 16-19, 23-26, 27, and 32 are not disclosed in TOYODA et al. cited by the Examiner.

PRAITIS et al. relates to a client system in which, when an error is detected, the browser analyzes the response to determine whether the response comprises a friendly error page, and when the response is not the friendly error page, the browser replaces the page returned in the response with a friendly page.

PRAITIS et al. analyzes a response header 94 contained in a response 90 (Fig. 6, 208 and col. 9, lines 36-37). However, the response 90 is a command communicated between the browser module 82 and the networking software module 86 (Fig. 5 and col. 7, lines 19-23), but is not an e-mail as required by the pending claims. PRAITIS et al detects whether an error occurred in the server, using a status code number contained in the response header 94 (Fig. 6, 210 and col. 9, lines 37-43).

Thus, PRAITIS et al. does not disclose a controller which searches for a predetermined image data fixed code “in the image data part of the e-mail” when the received e-mail is a multi-part structure. Rather, PRAITIS et al. analyzes a status code number in a response header 94 of the response 90 (not an e-mail). PRAITIS et al. does not disclose a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected, since PRAITIS et al. does not search for a predetermined image data fixed code in the image data part of the e-mail.

Further, PRAITIS et al. analyzes a response body 92 of a response 90 to determine whether the response body 92 is a friendly response (Fig. 6, 212 and col. 9, lines 52-62). However, this decision is not performed for determining whether an error occurs. Rather, when the response body 92 is not a friendly response, the browser of PRAITIS et al. displays (i.e., substitutes) a friendly page instead of the body of the response (col. 9, lines 63-66).

Thus, PRAITIS et al. does not disclose a controller which searches for a predetermined image data fixed code “in the image data part of the e-mail” when the received e-mail is a multi-part structure. Rather, PRAITIS et al. analyzes a response body 92 of the response 90 (not an e-mail). PRAITIS et al. does not disclose a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected. Rather, PRAITIS et al. replaces the

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page returned in response with a friendly page, when the response body is not a friendly response.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 16-19, 23-26, 27, and 32 are not disclosed in PRAITIS et al. cited by the Examiner.

The pending claims 16-19, 23-26, 27, and 32 are submitted to be patentable over the Examiner's proposed combination, since neither TOYODA et al. nor PRAITIS et al. disclose the combination of features recited in Applicant's claims. Moreover, there is submitted to be no proper motivation for the combination of the facsimile system of TOYODA et al. with the features of the software programs of PRAITIS et al. which relates to errors occurring at a server.

MORI relates to a network facsimile apparatus which receives electronic mail via a local area network and transmits facsimile data through facsimile communications procedures via PSTN.

MORI also discloses the sub-headers Z1, Z2, and Z3 including the boundary "Content-Type" (Figs. 5 and 7, and col. 11, lines 33-35). However, the boundary "Content-Type" is contained in a header of an e-mail, but not in a image data part of the body of the e-mail. Thus, MORI does not disclose a controller which searches for a predetermined image data fixed code "in the image data part of the e-mail" when the received e-mail is a multi-part structure.

Further, MORI does not disclose judging that the received e-mail is an error mail, as evidenced by Fig. 10AA. Rather, MORI detects series of characters to find the sub-headers (Fig. 10AA, S204, and col. 13, lines 53-57). MORI determines that contents of

an information file is a MINE formatted text (Fig. 10AA, S205 and col. 13, lines 63-67). MORI converts the MINE formatted text into original symbol/character codes (Fig.10AA, S206 and col. 14, lines 1-5). Thus, MORI does not contain any disclosure regarding a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 16-19, 23-26, 27, and 32 are not disclosed in MORI cited by the Examiner. The pending claims 16-19, 23-26, 27, and 32 are submitted to be patentable over the Examiner's proposed combination, since none of TOYODA et al., PRAITIS et al., and MORI disclose the combination of features recited in Applicant's claims. Nor has the Examiner set forth a proper motivation for combining the teachings of these diverse documents.

Regarding the Examiner's rejection of the dependent claims 28-29 and 33-34, since these claims are dependent from allowable independent claims 27 and 32, which are allowable for at least the reasons discussed *supra*, these claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record. Accordingly, the Examiner is respectfully requested to withdraw all rejections under 35 U.S.C. § 103(a).

In the rejection of dependent claims 28, 29, 33, and 34, the Examiner relied upon, inter alia, IWAZAKI. However, Applicant submits that IWAZAKI is not available as a reference against the pending claims. Applicant notes that the IWAZAKI

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reference issued as a patent on February 3, 2004 and was filed in the U.S. Patent and Trademark Office on May 31, 2000. Thus, its availability as a reference against any of the claims in the present application is only under 35 U.S.C. § 102(e). In this regard, Applicant notes that the present application is based on and enjoys the effective filing date of JP 11-321411 which was filed on November 11, 1999, which is before the 35 U.S.C. § 102(e) date of the IWAZAKI reference relied on by the Examiner. Thus, Applicant submits that the IWAZAKI reference is an inappropriate basis for the rejection of any of the claims in the present application.

In view of the fact that IWAZAKI was only applied in the rejection of several dependent claims, and in view of the clear evidentiary showing set forth above regarding the patentability of the respective independent claims, Applicant respectfully declines to file a certified translation of the priority document at this time.

Applicant further respectfully traverses the Examiner's position as set forth in the "Response to Arguments". Initially, Applicant did not make arguments regarding the age of the references. Rather, the availability of IWAZAKI was traversed based on the effective filing date of the present application.

Further, Applicant, in addition to arguing the shortcomings of the references individually, also asserted various deficiencies of the asserted combinations of references, for, inter alia, lacking proper motivation.

Regarding TOYODA et al., Applicant asserted that, the controller, as recited in the various claimed combinations, is not taught by TOYODA et al. A controller, as recited in the pending claims does not "naturally flow" from TOYADA et al. TOYADA et

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al. do not determine that an e-mail is error mail by determining whether the header includes a predetermined character string related to a sender of the error mail.

Accordingly, in view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections, and an indication of the allowability of all the claims pending in the present application, in due course.

**SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has resubmitted the pending claims for reconsideration by the Examiner.

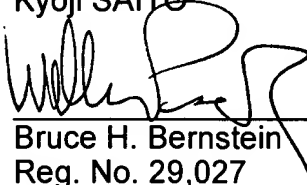
With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the pending claims with the disclosure of the references. Applicant also has pointed out the impropriety of the rejections as well as the inadequacy of the references relied on. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application, in due course.

Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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